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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,995	08/21/2001	George Kindness		9102

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BROOKE SCHUMM III
ONE NORTH CHARLES STREET
SUITE 2450
BALTIMORE, MD 21014

EXAMINER

ZEMAN, MARY K

ART UNIT PAPER NUMBER

1631

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,995

Applicant(s)

KINDNESS ET AL.

Examiner

Mary K Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Election/Restrictions

Applicant is advised to review the claims for proper dependency. At least claims 2-4 are improper, as they depend from themselves. Other claims clearly have incorrect dependencies, as can be determined by reading the preamble. The examiner has set forth the groups to the best of her ability to correct these dependencies. (for example, claim 40 should depend from claim 39, not 36.)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a method of treating a patient, comprising determining a sequence of particular gene clusters, and administering a compound of a particular class, classified in class 514, subclass 2+.
- II. Claim 10, drawn to a method of treatment of a patient, comprising determining a sequence, testing anti-oxidant capacity, and administering a compound, classified in class 514, subclass 2+.
- III. Claim 11, drawn to a method of treating a patient comprising determining a sequence, testing total thiol, and administering a compound, classified in class 514, subclass 2+.
- IV. Claim 12, drawn to a method of treating a patient comprising determining a sequence, testing glutathione levels and administering a compound, classified in class 514, subclass 2+.

- V. Claim 13, drawn to a method of determining propensity of a patient to a genetic disease, comprising determining a sequence, recording it and comparing it to another sequence, classified in class 702, subclass 20.
- VI. Claims 14-18, drawn to methods of determining propensity of a patient to genetic disease, comprising determining a sequence, comparing it to a known sequence, a former sequence, and an ancestral sequence, classified in class 702, subclass 19.
- VII. Claims 19-23, drawn to methods of evaluating a patient condition, classified in class 702, subclass 19.
- VIII. Claim 24, drawn to a method of determining propensity of a patient to complications in pregnancy, classified in class 702, subclass 20.
- IX. Claim 25, drawn to a method of determining the propensity of a patient to have complications from a vaccine, classified in class 702, subclass 19.
- X. Claim 26, drawn to a method of determining whether a patient is likely to develop complications related to COPD, classified in class 702, subclass 20.
- XI. Claims 27-28, drawn to methods of extending the life of a terminally ill patient, classified in class 702, subclass 19.
- XII. Claim 29, drawn to a method of evaluating a course of treatment for a patient, classified in class 702, subclass 20.
- XIII. Claims 30-36, drawn to methods of creating probable outcome data utilizing artificial intelligence, classified in class 706, subclass 11.

XIV. Claims 37-40, drawn to a method and system of rapid determination and evaluation of the impact of a person's genetics, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XIV are independent and distinct, each from the other, as they are drawn to differing methods. Each method comprises differing steps, utilizing differing data and information, to achieve differing goals. For example, the differing biochemical tests required from Inventions II, III and IV are separate and distinct, resulting in differing data to be analyzed. None of the tests is obvious over the other, and knowledge of the result of one test does not speak to results for any other biochemical test. Each method requires differing analysis of data to obtain answers to differing questions. For example, Invention V seeks to determine the likelihood that a patient will develop a disease; this is a very different question in comparison to Invention VII which seeks to evaluate a patient condition. Both of those methods are very different from a method of extending life of a patient. Each data analysis results in differing courses of action or inaction based upon those differing analyses. A Patient will be treated, or not treated, or given certain different information about their genetic tendencies, based upon the method performed. Each condition to be tested or analysis to be made is independent, and has a differing search area in the published literature, such that the search of more than one independent and distinct invention would pose an undue burden upon the examiner.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

The Official fax number for this Art Unit is: (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz
9/12/03


MARY K. ZEMAN
PRIMARY EXAMINER
